REMARKS/ARGUMENTS

In the Election/Restriction requirement dated October 31, 2007 the Examiner delineated the following inventions as being patentably distinct:

Group I, Claims 1-14 and 16, drawn to a vast permutation of a modified amino-acid sequence compound, classified in class 514, subclass 2, for example; and

Group II, Claim 15, drawn to an antibody, classified in class 424, subclass 130.1, for example.

The Examiner further required the election of a single species.

Accordingly, Applicant provisionally elects with traverse Group I, Claims 1-14 and 16, and for a species the compound represented by formula (1) in Example 1.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions in regard to patentable distinction (M.P.E.P. § 803). Moreover when making a lack of unity of invention in a national stage application, the Examiner has the burden of explaining why each group lacks unity with each other group (i.e. why there is no single inventive concept) specifically describing the unique special technical feature in each group. (M.P.E.P. § 1893.03(d)).

Applicant respectfully traverses the restriction requirement on the grounds that the Examiner has not carried the burden of providing any reasons and/or examples to support any conclusions that the claims of the restricted groups are patentably distinct, or providing any reasons and/or examples to support any conclusions that the groups lack unity of invention.

The Examiner asserts that Group I and II do not relate to a single general inventive concept under PCT Rule 13.1 and 13.2 because they lack the same corresponding special technical feature.

The Examiner, however, has not considered that the claims in each group are considered related inventions under 37 C.F.R. § 1.475(b) in which the inventions are considered to have unity of invention. Applicant submits that while PCT Rule 13.1 and 13.2 are applicable 37 C.F.R. § 1.475(b) provides, in relevant part that "a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to (3) a product, process, and the use of said product."

In the instant claimed invention, the compounds of Claims 1-14 and 16 are used to make the antibody of Claim 15.

The common inventive concept that links SEQ ID NO: 1, 2, 3 and 4 as a single inventive entity is that the peptide bond -CONH (amide group) that links Leu to the adjacent amino acid is replaced by a hydroxyethylene group (-CHOH-CH_2-) and where the N terminus has an alkoxy carbonyl group (COO alkyl) or a terminal amide group (-N-CO-). It is the modified change that contribute to the pharmaceutical properties of the claimed invention. Accordingly, Applicant requests that all the claims be examined together.

In chemical cases, a specified group of materials which do not necessarily belong to an otherwise class can be examined together if together they claim operable substances that cannot be defined by generic language but which nevertheless have a community of chemical or physical characteristics. They need only possess one property in common which is mainly responsible for their function in the claimed relationship. The common characteristic and utility in a generic sense suffices.

Applicant makes no statement regarding the patentable distinctness of the species but note that for the restriction to be proper there must be patentable differences.

Finally Applicant respectfully submits that should the elected invention be found allowable, the Office should expand its search to include the non-elected groups.

Divisional applications filed thereafter claiming the non-elected species should not be subject to a double patenting ground of rejection. 35 U.S.C. § 121, In re Joyce (Comr. Pats. 1957) 115 USPQ 412.

Applicant submits that the above-identified application is now in condition for examination on the merits and an early notice of such action is earnestly solicited.

Respectfully submitted,

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